

REMARKS

This paper is responsive to the Office Action dated August 19, 2003, and relates to the above-identified application with serial number 09/970,409, and filing date October 3, 2001. Claims 21-34 are pending in this application, stand rejected, and are at issue herein.

Claims 21-34 stand rejected under 35 U.S.C. § 102(a, b) as being anticipated by Microsoft's commercial product Visual Basic 5.0. Claims 21-34 are further rejected under 35 U.S.C. § 102(a, b and e) as anticipated by "Smalltalk-80: The Interactive Programming Environment," Adele Goldberg; Xerox Palo Alto Research Center (Xerox PARC); 1984.

Claim 35 has been added. Support for Claim 35 can be found in the Specification, Page 14.

The Applicant would now like to address the concerns stated in the Office Action and respectfully requests reconsideration of the rejections based at least in part on the traversal provided below.

*Rejection of Claims 21-34 – Visual Basic 5.0*

Applicant respectfully traverses the rejection over *Visual Basic 5.0* and requests reconsideration of the rejection. 35 U.S.C. § 102(a, b) provides that the Applicant is entitled to a patent unless "a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent, or (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

The office action paragraph 4 states that the Visual Basic product version 5.0 is documented by references from before and after the file date. For purposes of the rejection, Applicant respectfully states that Microsoft is an assignee of the above-identified application.

Applicant respectfully requests that the references be removed from consideration because those references that were dated within one year prior to the file date originated with or were obtained from the Applicant. The relevant date for determining the one year period is the filing date of the parent application, May 27, 1997. More particularly, the patent application claims priority, as shown on the filing receipt, as a continuation of Application No. 09/391057, filed September, 1999, which is a continuation of Application No. 08/863,822, filed on May 27, 1997, now U.S. Pat. No. 6,026,233. The matter cited in Microsoft Office Developer Web Forum, dated October 14, 1996, was published within the one year period after the filing of the patent application. In accordance with MPEP 716.10, attached hereto is a Declaration under 37 CFR 1.132 providing the relevant facts pertaining to the references cited in the office action. The Declaration by Matthew James Curland, a co-inventor for above-described patent application demonstrates that the relevant portions of the references related to Visual Basic 5.0 originated with Mr. Curland and his co-inventors.

*Rejection of Claims 21-34 – Smalltalk 80*

Smalltalk 80 teaches a programmer's assistant that requires a programmer to select text, then choose a yellow button prior to a list of possible actions appearing. Importantly, if the text is not selected, nothing happens. See page 354-355. Each of independent Claims 21, 23, 25, 32 and 35 require "automatic" appearance of a passive assist window or automatically displaying a dynamic list (Claim 23). Thus, Smalltalk 80 fails to teach or suggest Claims 21, 23, 25, 32 or 35. Claims 22, 24, 26, 27, 28, 29, 30, 31, 33 and 34 depend from their respective independent claim and are allowable with the independent claim.

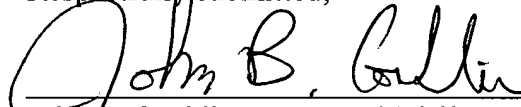
In re Appln. of SHULMAN et al.  
Application No. 09/970,409

CONCLUSION:

The rejections of Claims 21-34 under 35 U.S.C. 102(a, b and e) have been traversed, and new Claim 35 has been added. No new matter has been added thereby.

The Application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this Application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject Application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



John B. Conklin, Reg. No. 30,369  
One of the Attorneys for Applicant(s)  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 North Stetson Avenue  
Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

Date:

